SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, A.D. 1973

No. 73-1677

BORG-WARNER CORPORATION,

Petitioner,

vs.

KING-SEELEY THERMOS CO.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

RICHARD R. TREXLER
JOHN S. FOSSE
OLSON, TREXLER, WOLTERS, BUSHNELL & FOSSE, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604

DONALD W. BANNER
200 S. Michigan Avenue
Chicago, Illinois 60604

ATTORNEYS FOR PETITIONER

Midwest Law Printing Co., Chicago 60601, FInancial 6-3988

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KING-SEELEY THERMOS CO.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered on October 31, 1973, in its cause numbered 72-1985.

OPINIONS BELOW

The Findings and Conclusions of the District Court for the Northern District of Illinois are unreported and are printed in Appendix A. The decision of the Court of Appeals for the Seventh Circuit is likewise unreported and is printed in Appendix B.

JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered on October 31, 1973. A petition for rehearing was timely filed and denied on February 11, 1974. This Petition is filed within the ninety days permitted under Title 28, U. S. Code, Section 2101(a).

Jurisdiction of this Court is invoked under Title 28, U. S. Code, Section 1254(1).

THE PROBLEM IN THIS CASE

In the courts below, validity and infringement of the patent in suit were judged, not upon the disclosure or claims presented to and passed upon by the Patent Office, but upon the disclosure imported into the patent by the judiciary under the doctrine of inherency.

QUESTIONS PRESENTED

1. Is a patent enforceable, which depends for validity on subject matter not disclosed or claimed and not known to the patentees at the time the application for patent was filed, in view of the constitutional standard for patents and the statutory requirement (35 U.S.C. 112) that a patent must both contain a written description of the invention and particularly point out and distinctly claim it?

2. Does the judicially created doctrine that a patentee is entitled to benefits inherent in his invention override the constitutional and statutory requirements that the patent contain a description of the invention and a distinct statement of the monopoly?

THE CONSTITUTIONAL PROVISION HERE INVOLVED

ART. I, SEC. 8. The Congress shall have the power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

STATUTES HERE INVOLVED

Title 35 U.S. Code, Sec. 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

STATEMENT OF THE CASE

This is a patent infringement suit brought against Petitioner, Borg-Warner Corporation, charging it with infringement of Claim 4 of U. S. Patent No. 2,753,694 owned by Respondent, King-Seeley Thermos Co.

The patent in suit (hereinafter, the '694 patent) relates to an ice chip producing machine. It discloses a freezing cylinder surrounded by a refrigeration jacket, the cylinder having a rotatable auger in it for scraping the ice from the interior wall of the freezing cylinder and conveying it upward to the discharge end of the cylinder.

The one element of the '694 patent not present in the prior art is the means for breaking up and removing the ice from the auger at the discharge end of the cylinder. The ice breaking and removal element shown by the '694 patent is a cylindrical bushing (Fig. 4) having a beveled surface with a splitting edge at the lower end which faces the upper end of the auger (Fig. 3).

While the application for the '694 patent was still pending in the Patent Office, Respondent filed a later application for a patent on another invention which issued as U. S. Patent No. 2,825,209 (hereinafter, the '209 patent). Both patents '694 and '209 had two inventors; but only one of the inventors—Nelson—was involved in both patents.

The invention of the later filed '209 patent was represented to the Patent Office as an improvement on the '694 patent. The public was informed, in the '209 patent,

that "a problem existed in the removal of the ice from the auger shaft" of the '694 device and that

> ". . . If the auger (of the '694 machine) is run at a sufficiently slow speed to produce solid ice pieces, freeze-ups have occurred which prevent rotation of the auger and at times cause distortion of the auger shaft."

The later '209 patent specification continues:

> "It is an object of the present invention to provide a highly efficient ice flake producing machine which is constructed to freeze only relatively slushy masses of ice and to progressively convey said masses to a restricted compressing and discharging guideway for positively removing the slushy masses from the auger and guiding the same through a restricted discharge opening and thereby remove a substantial portion of the water in said masses before ejection, and discharge relatively clear ice."

There is not one word in the specification or claims of the patent in suit—the '694 patent—referring to production of slush ice and making ice chips by compressing or compacting or extruding or otherwise dewatering the slushy ice. On the contrary, the first mention of producing slushy ice and compressing it to produce ice chips occurs in the later '209 patent. This later patent, also owned by Respondent, has a pair of inventors different from that of the patent in suit. There are different inventive entities, even though there is one inventor common in both patents.* The fact of different inventive entities precludes there being any common inventive concept

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* *Manual of Patent Examining Procedure*, Section 804.

which might otherwise indicate that the inventors of '694 recognized the fact of making slushy ice and compressing it in the machine of '694.

In fact, the Court of Appeals acknowledged:

> ". . . the text of a subsequent patent (the '209 patent) issued to one of the inventors of '694 suggests that the significance of the '694 patent as a method of compacting relatively slushy masses of ice was not realized or understood by the inventors until later."

The Court of Appeals recognized what was omitted from the '694 patent and flatly stated in its opinion (App. 3b):

> **". . . neither the specification nor claims in the '694 patent contain any reference to making ice chips by compaction and extrusion."**

Being fully aware (1) that there is nothing in the '694 patent referring to producing slushy ice and then compressing or dewatering it and (2) that there was a need to remedy these deficiencies by relying on the disclosure contained in the later '209 patent, the Court below nevertheless upheld the validity and infringement findings of the District Court. Indeed, the Court of Appeals affirmed the validity of the '694 patent over the prior art "Nitsch machine" and the infringement by Petitioner, even though it was specifically aware of those deficiencies.

District Court Finding 15 imputes to '694 the exact thing which '209 says is not there. Finding 15:

> "It is the combination covered by claim 4 of the '694 patent and characterized by obstructing and deflecting surfaces in the upper end of the auger flight against which the slushy column of ice is conveyed by the rotating auger *so that a column of*

soft or slushy ice is compressed, dewatered, broken up or fractured, and discharged from the cylinder as commercially acceptable discrete ice chips or particles which distinguishes Plaintiff's patented machines and Defendant's accused machines from the Nitsch patent and the Nitsch machine and which has made Plaintiff's and Defendant's machines successful." (emphasis added)

The legal basis by which this critical but undescribed and unclaimed "disclosure" was imported by the Court of Appeals into the '694 patent from the later '209 patent is found in this statement (p. 2):

". . . the patentee is entitled to benefits inherent in his invention even if not understood at the time of its discovery."

REASONS FOR GRANTING THE WRIT

The quality of the information disclosed in a patent is a matter lying at the very foundation of the patent system. Indeed, the requirement that there be a *full* description of the invention, an adequate teaching of the invention to the public, is the *raison d'etre* of the patent system.

Obviously, nothing can be added to the sum of useful knowledge unless it is disclosed.

Without a full and complete disclosure, there is no *quid pro quo* for the grant of a patent monopoly and no compliance with the constitutional purpose of the system. As this Court stated in *Graham* v. *Deere* (383 U.S. 1, at 5):

> ". . . things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the progress of . . . useful arts.' This is the *standard* expressed in the Constitution and it may not be ignored."

Despite that clear statement, it is apparent that such constitutional standard is being ignored. It is specifically being ignored by the Seventh Circuit, as evidenced by the case at bar.*

Moreover, the patent in suit has been the subject of repeated litigation before twelve Federal Courts in three Circuits; and while there have been disparate findings upon the issue of infringement, several of those courts have held, in one form or another, that the patent in suit —despite the admitted and obvious failure of disclosure in the specification and claims:

> ". . . clearly discloses a process of making a column of slush ice, or soft ice, in a freezing compartment, and then compressing it against the breaker-head, by means of an auger, for disintegration and removal of excess water. . . ." (*King-Seeley Thermos Co.* v. *Refrigerated Dispensers, Inc.*, 10 Cir., 1965, 354 F. 2d 533, 537).

In each of those several cases, the validity of the patent in suit was judged, not upon the disclosure or claims presented to and passed upon by the Patent Office, but upon the disclosure imported into the patent by the judiciary under the doctrine of inherency. (See, e.g. Finding

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* A similar failure to meet the constitutional standard was recently before this Court from the Ninth Circuit on Petition for Certiorari, No. 73-1384 (*Ardac, Inc., et al* v. *Micro-Magnetic Industries, Inc.*, 488 F.2d 770, cert. den.).

15 of the trial court quoted at pp. 6 and 7 above). And infringement, where found, has been on the same basis. In the prior litigation—and in this—infringement was found because the accused devices employed the judicially created and imported disclosure said to be inherent; not because of any use of what is actually disclosed and claimed by the '694 patent.

The guidance of this Court is urgently required to resolve the lack of uniformity in the decisions on the requirements for full patent disclosure.* As stated above, the Seventh and Ninth Circuits have not been consistently meeting the constitutional requirements. On the other hand, the Second Circuit, in its most recent decision on the point, is in full compliance with those requirements. In the recent case of *Carter-Wallace Inc.* v. *Otte*, 474 F. 2d 529, the plaintiff sought to sustain its patent on the ground that the chemical compound involved inherently possessed certain valuable properties not described in the patent specification. The Court of Appeals for the Second Circuit rejected the patentee's argument and held the patent invalid. It stated that properties "must be disclosed in the patent application in order to be relied upon as a basis for patentability."

In contradistinction, the Court of Appeals for the Seventh Circuit, in the case at bar, has held the '694 patent valid even though that Court flatly acknowledges that neither the specification nor the claims of '694 "con-

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* In conformance with Rule 19(1)(b), this case involves both a conflict between the Circuits and a decision by the Court of Appeals, on a federal question, in conflict with applicable decisions of this Court.

tain any reference" to the function relied on to sustain validity and infringement.

Furthermore, the statutory provision (35 U.S.C. 112), implementing the constitutional requirement, specifically states that the patent "shall contain a written description of the invention" and that the patent claims must particularly point out and distinctly claim that invention. This is also being ignored by the Courts below. In the case at bar, an "afterthought" of the type condemned by this Court in *Lincoln Engineering Co. of Illinois* v. *Stewart-Warner Corp.*, 303 U.S. 545, has been incorporated into the '694 patent by the Seventh Circuit Court of Appeals to complete a deficient patent specification. Such an egregious violation of both the constitutional and statutory requirements has a most serious adverse effect on the public interest.

Where, as here, the specification is silent with respect to a critical function of the apparatus, the Patent Office cannot examine the application in the light of that feature. Certainly it cannot apply the *Graham* v. *Deere* validity test if it is not told what the invention consists of. And after the patent issues, how can the public construct and use the invention or understand the metes and bounds of the patent monopoly when "neither the specification nor the claims in the '694 patent contain any reference" to the invention? It is respectfully submitted that the judicially formulated doctrine that the "patentee is entitled to benefits inherent in his invention even if not understood at the time of its discovery" was never intended to—and cannot—supplant the clear constitutional and statutory standards for adequacy of both patent disclosure and claiming.

The effect of the decision by the Court below is to abort the functions which the statutory requirements are designed to fulfill as delineated by this Court in *Permutit Co.* v. *Graver Corporation,* 284 U.S. 52, at 60, as follows:

> ". . . The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not."

This Court should decide and make clear, whether the doctrine of "inherency", or any other judicially conceived doctrine or philosophy, may abrogate the requirements of 35 U.S.C. 112 that the specification of an issued patent, for validity and enforcement of that patent, must set forth the invention "in such full, clear, concise and exact terms as to enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same" and, in its claims, "particularly point out and distinctly claim" the invention, leaving nothing to surmise and speculation.

Should not a person "skilled in the art" be able to ascertain the invention of a patent by reading that patent? This Court has said so in *Permutit Company* v. *Graver Corporation, supra.* If it is necessary first to build the machine before one can "discover" its principle, there has then been no teaching of the invention by the patent itself, in conformance with the mandate of the statute. The production of slushy ice and the compression which the Court has found to be the gist of the monopoly of the

'694 patent does not appear either from the specification or the claims of the patent, and the Court below so states in its own opinion: ". . . neither the specifications nor the claims in the '694 patent contain any reference to making ice chips by compaction and extrusion. Moreover, the text of a subsequent patent issued to one of the inventors of '694 suggests that the significance of the '694 patent as a method of compacting relatively slushy masses of ice was not realized or understood by the inventors until later."

The mandate of 35 U.S.C. 112 has not been met, and unless this critical statute is to be disregarded, the decision of the Court below must be reversed.

CONCLUSION

There is a pressing need for clarification of the meaning of 35 U.S.C. 112 in light of the constitutional standard. Despite a need to safeguard the public interest—and despite repeated applications to this Court—there has been no decision by this Court on the requirements of patent disclosure since the Patent Laws were revised in 1952. Indeed, from the October 1968 term to the present time there have been over thirty Petitions for Certiorari filed in this Court in which 35 U.S.C. 112 has been a central issue. All have been denied. Obviously, not all raised the precise issue presented here; but all did, in one way or another, touch upon the appropriate standards for patent disclosure and claims.

The case at bar presents a unique opportunity for this Court to sweep away the existing confusion in the Courts below and return the patent system to full compliance with the explicit constitutional and statutory standards. There are no facts in dispute because the Court of Appeals for the Seventh Circuit has in its decision framed the issue with admirable clarity. This case, therefore, presents an opportunity singular in its simplicity by which the appropriate constitutional and statutory standards for disclosures and claims in patents can be clearly defined. This Court may readily here and now cut through the judicial incrustations grafted onto the patent system —such as misapplications of the "inherency" doctrine— and return the system to the standards which the Statute and the Constitution require.

Petitioners therefore pray that the Writ of Certiorari be granted.

Respectfully submitted,

RICHARD R. TREXLER
JOHN S. FOSSE
OLSON, TREXLER, WOLTERS, BUSHNELL & FOSSE, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604

DONALD W. BANNER
200 S. Michigan Avenue
Chicago, Illinois 60504

ATTORNEYS FOR PETITIONER

APPENDIX A

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

KING-SEELEY THERMOS CO.,
Plaintiff,

v.

BORG-WARNER CORPORATION,
Defendant.

No. 68 C 1057

FINDINGS OF FACT, CONCLUSIONS OF LAW AND JUDGMENT ORDER

This is an action for patent infringement by King-Seeley Thermos Co., Plaintiff, against Borg-Warner Corporation, Defendant. Plaintiff is a Delaware corporation having its principal office at Ann Arbor, Michigan, and its Queen Products Division is engaged in the manufacture and sale of flake or chip ice producing machines. Defendant, Borg-Warner Corporation, is a Delaware corporation, having its principal office and place of business at Chicago, Illinois and its York Division is engaged in the business of manufacturing chip ice producing machines. There is no issue as to jurisdiction or venue. Plaintiff charges that Defendant's ice making machines Models AD15, AD20, AD30, AD40, AD60, AD15R, AD20R, AD30R, AD40R and AD60R, infringe claim 4 of United States Letters Patent No. 2,753,694 (hereinafter referred to as "the '694 patent").

(Appendix A)

Defendant for its answer, and in its counterclaim, denies infringement of the patent claim in suit and alleges that the patent claim is invalid.

Claim 4 of the '694 patent reads as follows:

> "4. An ice chip producing machine comprising an elongated freezing chamber having an open end, means for supplying water to the inside of said freezing chamber, means for cooling at least a portion of said freezing chamber to freeze ice on the inside surface thereof, an ice conveying auger rotatably mounted in the freezing chamber with its spiral edge disposed in closely spaced relation to the inside wall of said chamber, means for constantly rotating the auger to cause said spiral edge to shear off ice frozen on the inside wall of the chamber constantly to deliver ice to said open end of the freezing chamber, and an outwardly inclined ice disintegrating and removing member positioned in said open end of the chamber and provided with an ice peeling mold-board-like surface positioned to engage ice carried by the auger, said constant rotation of the auger serving positively and constantly to convey ice to and force it against said mold-board-like surface to break up and positively remove ice from the auger and discharge it as discrete ice chips."

FINDINGS OF FACT

1. This action was filed on June 10, 1968, against Defendant charging infringement of the '694 patent and United States Patent No. 3,283,529. Prior to trial the complaint was dismissed with prejudice against Plaintiff in-

sofar as United States Patent No. 3,283,529 was concerned. Prior to trial it was stipulated that only claim 4 of the '694 patent would be litigated.

2. The '694 patent was duly and legally issued to Plaintiffs' predecessor, Queen Stove Works, Inc., on July 10, 1956, as the assignee of Fay A. Trow and Marcus Nelson, applicants of patent application, Serial No. 310,016, filed in the United States Patent Office on September 17, 1952. Plaintiff is the owner of the '694 patent and entitled to bring this action for its infringement and to all rights of recovery for infringement thereof.

3. Defendant is a Delaware corporation having its principal place of business in Chicago, Illinois, and has manufactured and/or sold within this district and elsewhere and within the six years next preceding the filing of this complaint, ice making machines which are identified as its AD15, AD20, AD30, AD40, AD60, AD15R, AD20R, AD30R, AD40R and AD60R models.

4. For the purpose of determining whether or not claim 4 of the '694 patent is infringed by Defendant's various ice making machines, it has been stipulated by the parties that all of Defendant's AD series accused machines may be considered to have the same structure and mode of operation even though there are some differences in dimensions and features not pertaining to the issue of infringement involved in this litigation.

5. Flake or chip ice made by machines involved in this litigation consists of individual relatively small pieces of ice which will not weld or mat together when stored in a storage bin and which can be easily scooped, handled, molded and pyramided and can be produced at relatively

low cost. Due to its method of manufacture, such ice is not completely dry and free of water.

6. In 1951, Plaintiff was manufacturing and selling machines for producing ice cubes and it was aware of a demand and need by its customers for relatively inexpensive machines which could manufacture low cost flake, chip or crushed ice on the premises of the customer. At that time a machine developed by Messrs. Nitsch and Hamner was submitted to Plaintiff as a saleable flake ice making machine. This machine is generally depicted in United States Letters Patent No. 2,597,515, which issued to Nitsch on his foregoing machine, although the machine also had a sheet metal splitter mounted above and outside the freezing cylinder which split the column of ice rising out of the cylinder but which did not materially affect the quality of the ice made in this machine.

7. Plaintiff's engineers experimented with the Nitsch machine in an effort to produce satisfactory flake ice, but could not do so under varying conditions to which such machines would be subjected in use throughout the country. These experiments led to the development of the '694 patented machines having a breaker head in the freezing chamber. With this machine, Plaintiff was for the first time able to produce commercially usable and saleable flake ice in a cylinder and auger type ice making machine.

8. Plaintiff's machines covered by the '694 patent have been successful and produce commercially usable and acceptable flake ice at less than the cost of crushed ice purchased from commercial ice companies. During the period June, 1952 through November, 1971, Plaintiff has sold approximately 260,000 devices covered by claim 4 of the

'694 patent having a sales value of approximately $133,000,000.00.

9. The '694 patent has been widely litigated and claim 4 here in suit has been held valid and infringed by the Tenth Circuit Court of Appeals in *King-Seeley Thermos Co.* v. *Refrigerated Dispensers, Inc., et al,* reported at 354 F.2d 533; by the Seventh Circuit Court of Appeals in *King-Seeley Thermos Co.* v. *Tastee Freez Industries, Inc.,* reported at 357 F.2d 875; by the United States District Court for the Northern District of Illinois in *King-Seeley Thermos Co.* v. *Cold Corporation of America,* reported at 182 FS 768; by the United States District Court for the District of Colorado in *King-Seeley Thermos Co.* v. *Ice-O-Matic, Inc., et al;* and by the Sixth Circuit Court of Appeals in *Uniflow Manufacturing Company* v. *King-Seeley Thermos Co.,* reported at 428 F.2d 335.

10. In 1962, Defendant's Engineering Department began work on the development of ice making machines which resulted in Defendant's accused ice making machines. Prior to that time, Defendant had been manufacturing and selling ice making machines of the drum type where water was sprayed on the outside surface of a refrigerated drum and then removed or gouged from the drum with an ice remover so as to produce a ribbon type ice. These drum type machines were discontinued by Defendant and were replaced by Defendant's accused AD series machines.

11. Both plaintiff's patented ice making machines and Defendant's accused commercial ice making machines were operated and made ice in courtroom demonstrations. These demonstrations clearly established that Plaintiff's patented machines and Defendant's commercial machines pro-

duced commercially satisfactory flake or chip ice which would not weld together in a storage bin.

12. Plaintiffs and Defendant's machines are sold in direct competition with each other and the ice products produced thereby serve the same purpose in the market place.

13. In both Plaintiff's patented machines and Defendant's accused machines, flake or chip ice is made by freezing ice on the inside wall of a cylinder, removing the ice from the wall of the cylinder and conveying it upwardly by an auger against obstructing and deflecting surfaces in the upper end of the cylinder so that the rising column of slushy ice is compacted, deflected, broken or fractured, and discharged out of the cylinder as discrete particles or chips of ice which will not mat or stick together in a storage bin, and which can be metered, scooped, pyramided and molded.

14. If the obstructing and deflecting surfaces are removed from Plaintiff's patended machine and Defendant's accused machines, they do not produce commercially acceptable ice. Further, if the compression loop, which deflects the ice outwardly through the side outlet, is removed from Defendant's machine, leaving the bearing member in place, the machine will not produce ice.

15. It is the combination covered by claim 4 of the '694 patent and characterized by obstructing and deflecting surfaces in the upper end of the auger flight against which the slushy column of ice is conveyed by the rotating auger so that a column of soft or slushy ice is compressed, dewatered, broken up or fractured, and discharged from the cylinder as commercially acceptable discrete ice chips or particles which distinguishes Plaintiff's patented machines

and Defendant's accused machines from the Nitsch patent and the Nitsch machine and which has made Plaintiff's and Defendant's machines successful.

16. While Defendant's upper bearing member and compression loop differ in form from the breaker head shown in the drawings of the '694 patent, both are located in the upper end of the freezing chamber and both have surfaces (including surfaces inclined toward the side outlet in the freezing chamber) which act to compress, dewater and fracture or break up the rising column of slush ice and discharge discrete ice particles or chips from the freezing cylinder, and constitute the "outwardly inclined disintegrating and removing member positioned in said open end of the chamber and provided with an ice peeling mold-board like surface" specified in claim 4 of the patent in suit.

17. The freezing chamber of Defendant's accused machine has an open upper end which is closed by the upper bearing housing in the same sense that the freezing chamber of the '694 patent has an open upper end which is closed by the member 23 of the '694 patent.

18. Defendant's accused machines produce discrete ice particles as distinguished from solid blocks or cubes of ice, and though somewhat larger and somewhat more regular in shape than the flakes or chips produced by the Plaintiff's commercial machines, can be scooped, molded and stored without matting in substantially the same manner as Scotsman flake ice, and clearly are "discrete ice chips" as called for in claim 4 in suit.

19. As harvested, Defendant's ice chips are somewhat drier or contain less water than do Plaintiff's flakes or

chips, but dryness when harvested is only a matter of degree and is not a controlling criterion, particularly since both Plaintiff's and Defendant's ice drains and so becomes drier during storage.

20. Moldboards may be of various shapes, curved or otherwise, and (unlike claims 3 and 6, not in suit, which specifically call for a concavely curved moldboard) there is nothing in the language of claim 4 in suit which limits claim 4 in suit to a concave or other curved shape, or imposes any limitation thereon which prevents its being infringed by Defendant's machine.

21. Defendant's accused machines have all of the elements called for in claim 4 of the '694 patent and function in substantially the same way to produce substantially the same results as the machine of the '694 patent.

22. Defendant uses a conveying tube with its accused machines into which ice is discharged from the machine freezing cylinder and conveyed to a storage bin which may be located remotely from the freezing cylinder. Demonstrations made to the Court showed that whether the ice is discharged directly from the freezing cylinder of Defendant's accused machine into a storage bin or is conveyed to a storage bin through the conveying tube, the ice discharged from the tube into the storage bin is substantially the same as that made without the tube. Defendant's conveying tube is thus merely an addition to the ice making mechanism of the '694 patent which does not significantly alter the essential characteristics or mode of operation of Defendant's ice making mechanism or the character of the ice product.

(Appendix A)

23. The prior patents to Ludke, No. 409,499 and Gay No. 1,963,842 relied upon by Defendant produce block ice which is clearly distinguished from the discrete ice chips produced by Plaintiff's patented machines and Defendant's machines, and so impose no limitations upon claim 4 which would prevent it from being infringed by Defendant's machine.

24. There is no file wrapper estoppel that prevents claim 4 of the '694 patent from being infringed by Defendant's accused machines and Plaintiff's subsequently issued patent No. 2,825,209 does not limit the scope of claim 4 of the '694 patent in suit so that Defendant's accused machines avoid infringement thereof.

25. As announced in open court at the conclusion of the trial, it is the finding of this Court that claim 4 of the '694 patent is valid.

26. Claim 4 of the '694 patent is infringed by all of Defendant's accused ice making machines, namely its models AD15, AD20, AD30, AD40, AD60, AD15R, AD20R, AD30R, AD40R and AD60R.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the parties hereto and of the subject matter of this litigation.

2. Claim 4 of patent No. 2,753,694 is valid and infringed by Defendant.

3. Patent claims should be interpreted and construed so as to uphold and preserve the inventor's rights and not destroy them.

(Appendix A)

Apex Electrical Mfg. Co. v. *Maytag Co. et al.*, 122 F.2d 182, CA7;
Adler Enterprises, Inc. v. *Carson, Pirie, Scott & Co.*, 218 FS 325, D.C.N.D. Ill. E.D.;
Holstensson v. *Webcor, Inc.*, 150 FS 441, D.C. N.D. Ill. E.D.

4. Patent claims are to be construed liberally, particularly when the patented invention has had significant commercial success or the patent is of the pioneer type.

Hunt et al., v. *Armour & Co.*, 185 F.2d 722, CA 7;
Chicago Patent Corp. v. *Genco Inc.*, 124 F.2d 725 CA 7;
Armstrong v. *Motorola*, 230 FS 337, D.C.N.D. Ill. E.D.

5. Patents are not limited to the embodiment of the invention described in the specification since the patent claims measure the invention. If the accused device achieves substantially the same results in substantially the same way as the patented device, the devices are the same in the eyes of the patent law.

Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 339 US 605, 608-609;
King-Seeley Thermos Co. v. *Tastee Freez Industries, Inc.*, CA 7, 357 F.2d 875, 880.

6. One appropriating the principle and mode of operation of a patented device, and obtaining its results by the same or equivalent means, may not avoid infringement by making a device different in form, even though it be more or less efficient than the patented device.

(Appendix A)

Paper Converting Machine Co. v. *FMC Corp.*, 409 F.2d 344, 353, CA 7 (1969);
Nordberg Mfg. Co. v. *Woolery Machine Co.*, 79 F.2d 685, 692, CA 7 (1935);
Weller Mfg. Co. v. *Wen Products, Inc.* at al., 121 FS 198, D.C.N.D. Ill. E.D. (1954).

7. The addition of an added element to a combination called for by a patent does not avoid infringement of the patent.

Holland Co. v. *American Steel Foundries*, 190 F.2d 37, CA 7;
Columbia Wire Co. v. *Kokomo Steel & Wire Co.*, 139 Fed. 116, CA 7.

8. A broad claim will not be construed to contain limitations expressed in other claims.

Chicago Pneumatic Tool v. *Hughes Tool*, CA 10, 97 F.2d 945, 947;
Hansen v. *Colliver*, CA 9, 282 F.2d 66, 69.

Wherefore, it is the order of this Court that Defendant is enjoined from further infringement of claim 4 of Patent No. 2,753,694. An accounting shall be had and Plaintiff shall be awarded such damages as are determined to arise out of the infringement by Defendant of claim 4 of Patent No. 2,753,694. Defendant's counterclaim is dismissed. Plaintiff's motion for the assessment of costs against defendant is denied; each party will bear its own costs.

Enter:

/s/ Frank J. McGarr
United States District Judge

Dated: October 13, 1972

APPENDIX B

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

Chicago, Illinois 60604

Argued September 27, 1973

October 31, 1973

Before

Hon. John Paul Stevens, Circuit Judge

Hon. Robert A. Sprecher, Circuit Judge

Hon. William J. Campbell, Senior District Judge*

KING-SEELEY THERMOS CO.,
Plaintiff-Appellee,

No. 72-1985 vs.

BORG-WARNER CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

No. 68-C-1057

Honorable Frank J. McGarr, Judge

ORDER

The district court found that defendant's machine for producing chip ice infringed claim 4 of plaintiff's '694 pat-

* Senior District Judge William J. Campbell of the Northern District of Illinois is sitting by designation.

ent.[1] The validity of that claim has been established. *King-Seeley Thermos Co.* v. *Tastee Freez Industries, Inc.*, 357 F.2d 875 (7th Cir. 1966). Defendant denies infringement on three grounds: (1) that its machines make ice by compaction and extrusion, a method basically different from that disclosed in the patent; (2) that its machines are, in all material respects, identical to those described in an earlier British patent, and therefore since the British patent did not anticipate '694, necessarily defendant's machines do not infringe; and (3) that claim 4 is limited to a machine containing an "ice disintegrating and removing member . . . provided with an ice peeling mold-board-like surface," a feature not found in defendant's machine. We are persuaded that each of these contentions is foreclosed

---

[1] Patent No. 2,753,694, an ice disintegrating and chip delivering spiral ice chip producing machine issued to Trow and Nelson on July 10, 1956. The claim in suit reads as follows:

> "4. An ice chip producing machine comprising an elongated freezing chamber having an open end, means for supplying water to the inside of said freezing chamber, means for cooling at least a portion of said freezing chamber to freeze ice on the inside surface thereof, an ice conveying auger rotatably mounted in the freezing chamber with its spiral edge disposed in closely spaced relation to the inside wall of said chamber, means for constantly rotating the auger to cause said spiral edge to shear off ice frozen on the inside wall of the chamber constantly to deliver ice to said open end of the freezing chamber, and an outwardly inclined ice disintegrating and removing member positioned in said open end of the chamber and provided with an ice peeling mold-board-like surface positioned to engage ice carried by the auger, said constant rotation of the auger serving positively and constantly to convey ice to and force it against said mold-board-like surface to break up and positively remove ice from the auger and discharge it as discrete ice chips."

by the district court's findings which, in our view, are definitely not clearly erroneous.

I.

Defendant correctly points out that neither the specifications nor the claims in the '694 patent contain any reference to making ice chips by compaction and extrusion. Moreover, the text of a subsequent patent[2] issued to one of the inventors of '694 suggests that the significance of the '694 patent as a method of compacting relatively slushy masses of ice was not realized or understood by the inventors until later. Nevertheless, as defendant acknowledges, the patentee is entitled to benefits inherent in his invention even if not understood at the time of its discovery.[3]

In this case, the district court expressly found that in a machine embodying the features described in claim 4 "a column of soft or slushy ice is compressed, dewatered, broken up or fractured, and discharged from the cylinder as commercially acceptable discrete ice chips." (Finding 15.) The portions of the record called to our attention by

---

[2] Patent No. 2,825,209 issued to Nelson and Roberts on March 4, 1958.

[3] "Defendant is aware of the rule that an inventor is entitled to all of the benefits of his invention, and if something is inherent in his machine, he is entitled to its benefits whether he knew of them or not." Appellant's reply brief 16. See *Talon, Inc.* v. *Union Slide Fastener, Inc.*, 266 F.2d 731 at 734 (9th Cir. 1969). Appellant argues that a benefit cannot be "inherent" within the meaning of this rule if the inventor was not aware of the benefit. But the very statement of the rule, which defendant accepts, assumes lack of knowledge by the inventor.

the parties persuade us that the finding refers to a machine which embodies the features of the claim in suit without also embodying the improvement described in the later '209 patent. Therefore, the fact that defendant's machine also makes ice chips by compression, dewatering and fracturing does not avoid the conclusion that it infringes the patent in suit.

II.

Relying on the rule that "that which infringes, if later, would anticipate if earlier," *Peters* v. *Active Mfg. Co.*, 129 U.S. 530, 537, defendant contends that the British patent to Ludke which issued in 1934 disclosed the feature of defendant's machine which plaintiff accuses. It follows, according to defendant, that either there is no infringement or else the patent is invalid.

The district court found, however, that the subject matter of Ludke is different from claim 4 of '694 and of the accused machine. Ludke's machine made block ice, whereas the parties' machines make chip ice. (See Finding 23.) Moreover, we think plaintiff correctly argues that Ludke does not disclose a breaker, mold-board, or other device described by the language of claim 4.[4] We are persuaded that Ludke does not anticipate '694, and that the accused machine is also sufficiently different from Ludke to qualify as an infringing device.[5]

---

[4] Although slushy ice may be compressed in chamber K', and therefore the chamber performs one of the functions (i.e., the undescribed function) of the ice disintegrating and removing member (23) in patent '694, we find no such member in Ludke.

[5] We find nothing in Ludke comparable to the blade portion (62) of element 60 of patent 3,371,505.

(Appendix B)

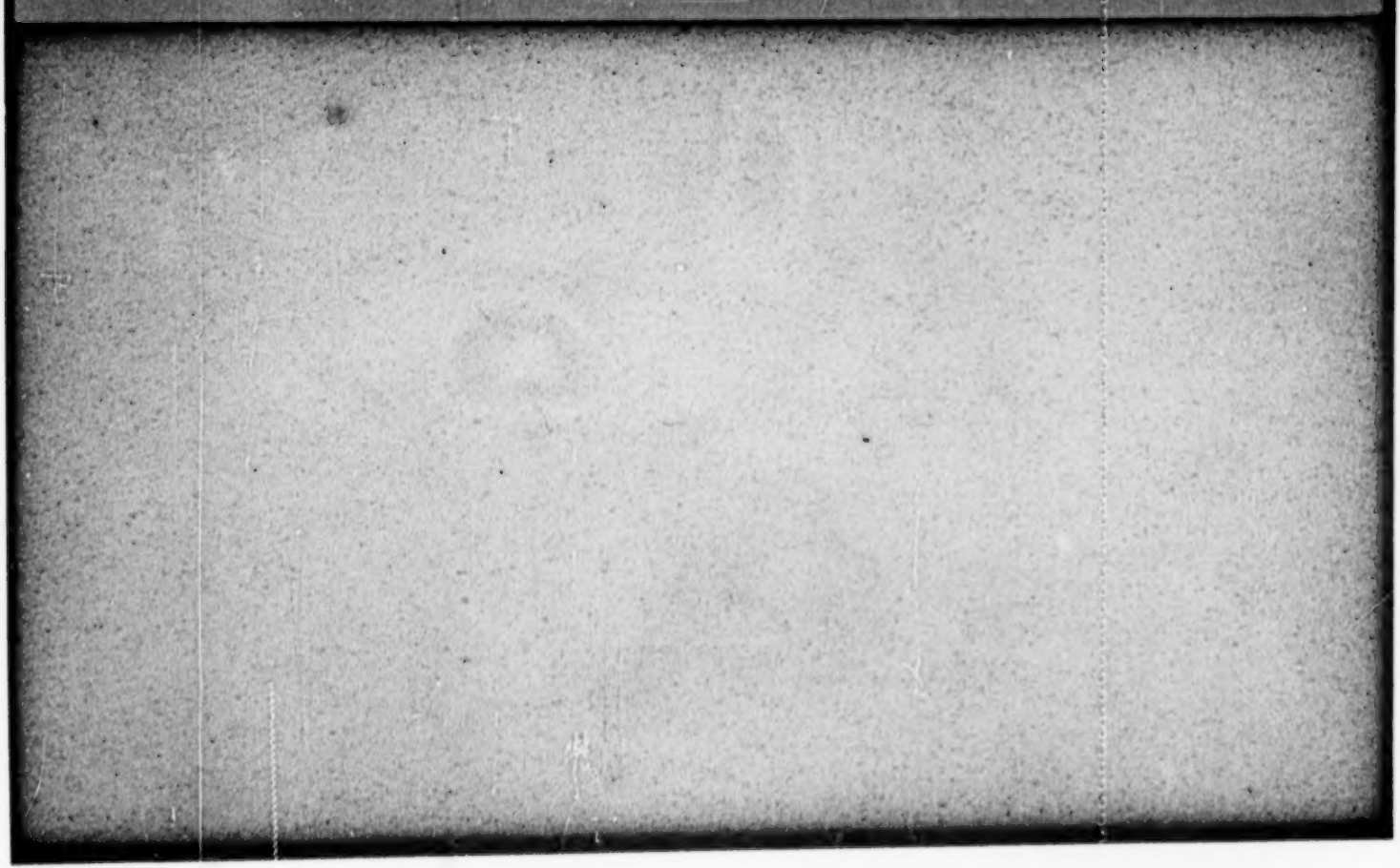
III.

Defendant is arguing that a "plow-shaped" mold-board-like surface must be curved like a conventional plow. However, not all plows are conventional curved surfaces. *Cf.*, *King-Seeley Thermos Co.* v. *Refrigerated Dispensers, Inc.*, 354 F.2d 533, 540 (10th Cir. 1965). Moreover, as claim 3 illustrates, if a limitation to curved surfaces were intended, it could easily have been stated expressly. *Cf.*, *Smith* v. *Snow*, 294 U.S. 1, 13-14. We think the district court correctly found that the differences between defendant's upper bearing member and compression loop do not avoid infringement of the breaker head shown in the drawings of the '694 patent. (See Finding 16.)

We have considered the discussion of patent '209. Assuming *arguendo* that '209 is invalid, and, further, that '209 demonstrates that the inventor did not understand the benefits inherent in the '694 conception, we are nevertheless satisfied that '209 does not undermine the established validity of '694 or avoid the charge of infringement.

The judgment is

Affirmed.



SUPREME COURT, U. S.

JUN 4 1974

MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1677

BORG-WARNER CORPORATION,
Petitioner,

vs.

KING-SEELEY THERMOS CO.,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

DON K. HARNESS
Attorney for Respondent

HARNESS, DICKEY & PIERCE
1500 N. Woodward
Birmingham, Michigan 48011
Tel. (313) 642-7600

Interstate Brief & Record Co., 303 Bandini St., Detroit, Michigan 48226
WO. 3-4242—WO. 3-4243

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIOTARY TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

COUNTERSTATEMENT OF QUESTIONS PRESENTED

Petitioner (hereinafter called "Borg-Warner") lists two questions for consideration by this Court. Respondent (hereinafter called "King-Seeley") submits however that based on

the proceedings in this matter the question Borg-Warner has really raised is:

1. Is a patent which fully illustrates, discloses and claims a novel machine invalid under the provisions of 35 U.S.C. 112 because it fails to mention one of the many functions of the machine.

SUPPLEMENTAL STATEMENT OF THE CASE

This is the last of a long line of patent infringement cases brought by King-Seeley against a number of companies who infringed King-Seeley's United States Patent (U. S. Patent No. 2,753,694, hereinafter referred to as the " '694 patent"). The patent discloses and claims a machine for making chip or flake ice and is a basic patent covering an invention which revolutionized the art of making such ice. Only claim 4 of the patent is here in suit and as pointed out in the District Court decision Finding of Fact No. 9 (which appears on page 5a of the Appendix to Borg-Warner's Petition) this patent claim has been held valid in each of those prior suits.

Petitioner in its Statement of the Case attempts to convey the impression that the '694 patent fails to describe the patented machine in terms which would enable any person skilled in the art to make and use the same and that claim 4 does not claim the machine of the invention,

all as required by 35 U.S.C. 112. Nothing could be further from the truth. The '694 patent does fully disclose a machine which produces satisfactory chip or flake ice and Borg-Warner made no contention during the trial of this case nor in the briefs before the District Court or the Court of Appeals that claim 4 was invalid under 35 U.S. C. 112. In fact, in its brief to the Seventh Circuit Court of Appeals, Borg-Warner stated that it is aware of the rule that an inventor is entitled to all of the benefits of his invention, and if something is inherent in his machine, he is entitled to those benefits whether he knew them or not, but there is no inherency in this case. Thus, in the District Court and in the Court of Appeals, Borg-Warner only argued that a machine made in accordance with the disclosure of the '694 patent would not inherently compress the rising column of ice. The contrary was found to be true by the District Court after it witnessed various courtroom demonstrations of the machine illustrated and disclosed in the '694 patent in suit.

The argument that the ice disintegrating and removing member in the upper end of the cylinder of the machine shown in the '694 patent would not inherently compress the rising column of ice was made in all of the prior litigation involving the '694 patent and rejected by every court including the Tenth Circuit Court of Appeals, the Seventh Circuit Court of Appeals and the Sixth Circuit Court of Appeals. For instance, the Tenth Circuit Court of

Appeals stated in the case of King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc., 354 F.2d 533

> "We think that Claim 4 of the 694 Patent clearly discloses a process of making a column of slush ice, or soft ice, in a freezing compartment, and then compressing it against the breaker-head, by means of an auger, for disintegration and removal of excess water; this is new and novel. The breaker-head serves no other purpose. Furthermore, even though the patent claim did not specifically use the terms 'slush ice', and 'compression', the patentee is entitled to all the benefits and advantages of his patent. Radio Corp. of America v. Radio Engineering Laboratories, 293 U.S. 1, 55 S. Ct. 928, 79 L. Ed. 163, reh. denied 293 U.S. 522, 55 S. Ct. 66, 79 L. Ed. 634; Talon, Inc. v. Union Slide Fastener, Inc., 9 Cir., 266 F.2d 731; Tropic-Aire, Inc. v. Cullen-Thompson Motor Co., 10 Cir., 107 F.2d 671; Byers Machine Co. v. Keystone Driller Co., 6 Cir., 44 F.2d 283, cert. denied 293 U.S. 572, 55 S. Ct. 103, 79 L. Ed. 670; Horton Mfg. Co. v. White Lily Mfg. Co., 7 Cir., 213 F.471."

The '694 patent in suit discloses and covers the first successful flake ice machines made by King-Seeley and those machines were commercially sold. King-Seeley obtained a later patent, U. S. Patent No. 2,825,209 (hereafter called the " '209" patent), which discloses an improved version of the '694 patent machine wherein the ice disintegrating and removing member has two mold board surfaces and the freezing cylinder has two outlet windows which are smaller in size than the window in the '694 machine so that the rising column of ice is compressed even more than in the '694 patent machine. This later '209 patent cannot be used to invalidate the earlier '694 patent here in suit and the prior courts have so held.

The District Court here had an opportunity in courtroom demonstrations to see how a machine, made exactly in accordance with what is disclosed and claimed in the '694 patent, operated and to see how it made satisfactory chip or flake ice and the District Court had an opportunity to see how the prior art which did not employ the ice disintegrating and removing member called for in the '694 patent failed to make satisfactory ice. Furthermore, the District Court saw that the ice disintegrating and removing member of the '694 patent did compress the rising column of ice and this along with its other functions of breaking up the rising column of ice into chips or flakes and guiding the flakes out of the freezing cylinder so that the machine did not jam, are what made the '694 patent machine the highly successful

machine it has been. Claim 4 of the '694 patent specifically claims this machine and the machine is disclosed in detail in the patent specification and all of the prior courts have found that the fact that the patent fails to mention one of these functions of the ice disintegrating and removing member does not render the patent invalid and Borg-Warner has failed to cite any law to support its contention to the contrary.

REASONS FOR DENYING THE WRIT

1. The '694 Patent Fully Conforms with The Requirements of 35 U.S.C. 112

As pointed out above there is no evidence in the record of this case to support Borg-Warner's contention that the '694 patent is invalid under 35 U.S.C. 112. In the lower courts Borg-Warner contended that in the '694 patent machine compressing of the rising column of slush ice by the ice disintegrating and removing member not only did not occur but was not mentioned in the patent. The lower courts here, as in all the prior cases, found that a machine constructed in accordance with the disclosure of the '694 patent did compress the rising column of ice. This is a factual determination which should not be reversed unless clearly erroneous and Borg-Warner has not even contended that there is any such error.

King-Seeley's later issued '209 patent covers an improved version of the '694 patent

machine which operates on the same principle as that machine but makes an improved ice and is not relevant to any issue relating to the validity of the earlier '694 patent.

2. There is No Conflict Between Circuits

Borg-Warner argues on page 9 of its Petition that the Second Circuit Court of Appeals in the recent case of Carter-Wallace, Inc. v. Otte, 474 F. 2d 529 held contrary to the Seventh Circuit Court of Appeals in this case on the questions presented. This statement is not true. The facts in the Carter-Wallace case were completely different than the facts here and the principles of law involved are completely different. The Carter-Wallace case was a pharmaceutical case where the patented chemical compound was described in the patent as only having utility as an anticonvulsant and muscle paralyzant. The chemical compound for these uses was found to be obvious in view of certain prior art. The Appellant argued however that this compound had been found to be an excellent tranquillizer and that the compound was not obvious as a tranquillizer even if it was as an anticonvulsant and muscle paralyzant. There was however no mention in the patent of its possible use as a tranquillizer and the court said that therefore the patentee could not overcome this obviousness defense by referring to something not disclosed or referred to in the patent.

This is not at all as the situation here. In this case the prior art did not have the ice disintegrating and removing member in the upper end of the ice forming cylinder as disclosed and claimed in the '694 patent. Every prior court has found the '694 patent valid over this prior art and a patent which fully discloses and claims inventive subject matter is certainly not invalid under any provisions of the law simply because it fails to mention one of the many functions of the patented machine, particularly when that function is inherent in the claimed machine and has been found to be so by a multitude of courts.

Again, here the invention is the machine and the patent does contain a full and complete description of the machine and Claim 4 does particularly point out and distinctly claim that invention so that the factual situation in this case is completely different from the Carter-Wallace case and all of the Circuit Courts of Appeals that have passed on the '694 patent have found it valid. Thus here we have the antithesis of a conflict between circuits.

CONCLUSION

Borg-Warner's Petition stating that all the prior Courts of Appeals have misinterpreted 35 U.S.C. 112 is a sham in view of the facts in this case. Not only has Borg-Warner not raised this issue in the lower courts but it has

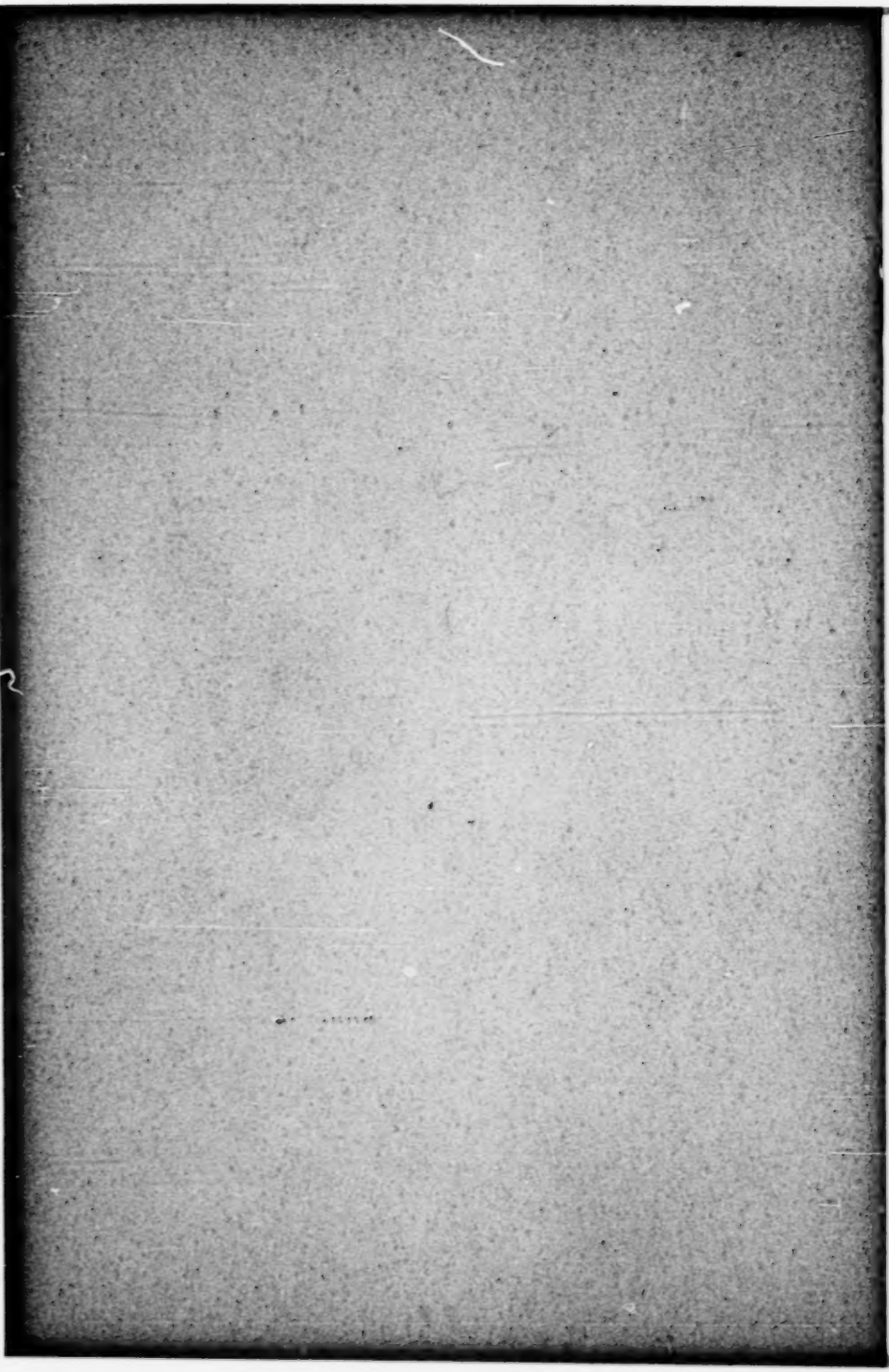
no basis for doing so in view of the fact that the '694 patent does clearly disclose and claim the invention as required by the patent statute. There is no conflict between any of the circuits and in fact all have uniformly held the '694 patent valid. The '694 patent has now expired and there is certainly no matter of great national interest or need involved in this case.

For the reasons set forth above Respondent prays that the Writ of Certiorari be denied.

Respectfully submitted,

DON K. HARNESS
Harness, Dickey & Pierce
1500 N. Woodward Ave.
Birmingham, Michigan
48011

Attorney for Respondent
King-Seeley Thermos Co.



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Respondent.

PETITIONER'S REPLY BRIEF

RICHARD R. TREXLER
JOHN S. FOSSE
OLSON, TREXLER, WOLTERS, BUSHNELL & FOSSE, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604

DONALD W. BANNER
200 S. Michigan Avenue
Chicago, Illinois 60604

ATTORNEYS FOR PETITIONER

Midwest Law Printing Co., Chicago 60601, Financial 6-3988

IN THE

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PETITIONER'S REPLY BRIEF

Respondent does not meet the question of whether its patent discloses the crucial feature of the invention. Rather, the Respondent seeks to divert the Court's attention away from the critical issue by the assertion that this is the "last" of the infringement suits on this patent, and that it has expired. Respondent fails to mention that infringement suits can still be brought on this patent for a period of up to six years after it expires.

Respondent argues that Petitioner did not, in the courts below, raise the critical issue presented here. Such is not the case. In its own Brief (on page 6), Respondent admits "In the lower courts Borg-Warner contended that in the '694 patent machine compressing of the rising column of slush ice by the ice disintegrating and removing member not only did not occur but was not mentioned in the patent".

Respondent's argument that there is no conflict between circuits is also incorrect. The Brief presented by Respondent does not mention the *Ardac* case, to which reference is made on page 8 of the Petition here. Furthermore, the Second Circuit *Carter-Wallace* case is directly contrary to the holding below here.

As in this case, earlier decisions on the patent in the *Carter-Wallace* case had all found the patent valid. However, when the deficient specification was called to the attention of the Second Circuit, it found the patent invalid. In doing so it stated:

> "The disclosure of a patent should, upon issuance, immediately add a patentable invention to the existing fund of knowledge in the field; it must do more than merely suggest experimentation which would lead to the discovery of the patentable property".

That decision also quoted Judge Learned Hand:

> "Even though it were possible that a person skilled in the art might see it was not absolute length, but the ratio of length to cross-section that was important, we should not be justified in validating such an expansion of the original; it is the sort of artful extrapolation against which courts have over and over set their faces. * * * A patent must be a certain guide; not a congeries of pregnant suggestions".

In contradistinction, the Seventh Circuit in this case found the patent valid even though it realized fully and explicitly stated ". . . neither the specification nor claims in the '694 patent contain any reference to making ice chips by compaction and extrusion".

Thus, that which the courts below found to be omitted was the very essence of Respondent's patent. In fact, the courts below specifically found that the *only* difference between the claim in suit and the prior art was the undisclosed, crucial function "that a column of soft or slushy ice is compressed, dewatered, broken up or fractured, and discharged from the cylinder as commercially acceptable discrete ice chips or particles. . . ." (Finding 15). The courts below also concluded that this sole difference between the patent and the prior art was not disclosed in the patent. Rather, they justified the omission through the doctrine of inherency.

The recent decision of this Court in *Kewanee Oil Co. v. Bicron Corp. et al*, ... U.S. ....., holds:

> "The stated objective of the Constitution in granting the power to Congress to legislate in the area of intellectual property is to 'promote the Progress of Science and useful Arts.' . . . In return for the right of exclusion . . . the patent laws impose upon the inventor a requirement of disclosure. To insure adequate and full disclosure so that upon the expiration of the 17-year period 'the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use' . . . the patent laws require that the patent application shall include a full and clear description of the invention and 'of the manner and process of making and using it' so that any person skilled in the art may make and use the invention. 35 U.S.C. 112.

> When a patent is granted and the information contained in it is circulated to the general public and those especially skilled in the trade, such additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of 17 years of exclusive use for its disclosure . . ."

If the foregoing conclusion by this Court is to be a vital part of the law in action, as distinguished from part of the library of dead legal lore, it is respectfully submitted that this Court must, in this case, construe 35 U.S.C. 112. There has been no decision on the requirements for patent disclosure since the Patent Laws were revised in 1952. Petitioner therefore prays that the Writ issue.

Respectfully submitted,

RICHARD R. TREXLER
JOHN S. FOSSE
OLSON, TREXLER, WOLTERS, BUSHNELL & FOSSE, LTD.
141 West Jackson Boulevard
Chicago, Illinois 60604

DONALD W. BANNER
200 S. Michigan Avenue
Chicago, Illinois 60604

ATTORNEYS FOR PETITIONER